

II. Claim rejections under 35 U.S.C. § 103(a)

The Examiner has rejected claims 1-20 under 35 U.S.C. § 103(a) over Downs (U.S. 6,226,619) in view of Colosso (U.S. 6,169,976).

For the purpose of the following discussion, the examiner is reminded that:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not on applicants' disclosure.

MPEP § 706.02(j) (emphasis added). Furthermore, as pointed out by the Patent Office Board of Appeals and Interferences:

The examiner should be aware that "deeming" does not discharge [her] from the burden of providing the requisite factual basis and establishing the requisite motivation to support a conclusion of obviousness.

Ex parte Stern, 13 USPQ2d 1379 (BPAI 1989).

A. Claims 1-11

Claim 1 is an independent claim and claims 2-11 depend from claim 1. Each of these claims requires a portable electronic device that includes a controller that is configured to control wireless transmission of digital content based upon meta-data associated with the digital content.

1. Independent claim 1

The Examiner has indicated that Downs discloses a portable media device "configured to control wireless transmission and rendering of digital content based upon

meta-data associated with the digital content.” Contrary to the Examiner’s assertion, however, Downs does not teach a portable media device having such a controller. With respect to portable consumer devices, Downs only teaches that digital content may be copied to a portable consumer device (see, e.g., col. 8, lines 48-53). There is no teaching in Downs that a portable consumer device may be configured to transmit digital content to another device. Indeed, the portable consumer device contemplated by Downs is configured to perform a subset of the functions of the End-User Player Application 195 that allows the portable device to process the content’s Usage Conditions that are embedded in a watermark (see, e.g., col. 11, lines 47-54). This suggests that portable consumer devices in Downs’ approach are not configured to perform other functions of the End-User Player Application 195, such as the function of copying digital content to other devices.

Colosso merely discloses a scheme for regulating the use of licensed products in accordance with which a customer purchases a licensed product from a distributor and subsequently connects to a licensor’s database to activate the licensed product. Colosso does not teach or suggest a portable electronic device that includes a controller that is configured to control wireless transmission of digital content based upon meta-data associated with the digital content.

Since neither Downs nor Colosso teaches or suggests the above-mentioned features of claim 1, no permissible combination of Downs and Colosso could have taught or suggested these features to one of ordinary skill in the art at the time of the invention. Accordingly, for at least this reason, the Examiner’s rejection of independent claim 1 now should be withdrawn.

## 2. Claims 2, 3, and 5

Each of claims 2 and 3 incorporates the features of independent claim 1 and therefore these claims are patentable for at least the same reasons explained above. These claims also are patentable for the following additional reason.

Claim 2 requires a portable media device that includes a controller that is configured to control playback of digital content stored in the memory based upon a user license confirmation. The Examiner has asserted that Downs discloses this feature. Contrary to the Examiner’s assertion, however, Downs does not teach or suggest such a feature. In Downs

approach, the End-User Player Application does not perform a user license confirmation. Indeed, there is no need for such a confirmation step because the End-User Player Application 195 is able to playback digital content based on whether the random Symmetric Key that was used to encrypt the digital content is located in the License Database 107 (see, e.g., col. 82, lines 23-39). Downs explains that the Clearinghouse provides the licensing authorization, not the End-User Player Applications (see, e.g., col. 7, lines 11-40).

Colosso also does not teach or suggest a portable media device that includes a controller that is configured to control playback of digital content stored in the memory based upon a user license confirmation.

Since neither Downs nor Colosso teaches or suggests the above-mentioned features of claim 2, no permissible combination of Downs and Colosso could have taught or suggested these features to one of ordinary skill in the art at the time of the invention. Accordingly, for at least this additional reason, the Examiner's rejection of claim 2 now should be withdrawn.

Claims 3 and 5 incorporates the features of claim 2 and therefore these claims are patentable for at least the same additional reason explained above.

### 3. Claim 4

Claim 4 incorporates the features of independent claim 1 and therefore claim 4 is patentable for at least the same reasons explained above. Claim 4 also is patentable for the following additional reason.

Claim 4 requires a portable media device that includes a controller that is configured to confirm a user license based upon a comparison of a user identifier embedded in the meta-data associated with digital content with a user identifier stored in a memory. The Examiner has asserted that Downs discloses this feature. Contrary to the Examiner's assertion, however, Downs does not teach or suggest such a feature. In Downs approach, there is no comparison of a user identifier embedded in the meta-data with a user identifier stored in the memory. Indeed, there is no need for such a comparison to confirm a user license because the End-User Player Application 195 is able to playback digital content based on whether the random Symmetric Key that was used to encrypt the digital content is located in the License Database 107 (see, e.g., col. 82, lines 23-39). Downs explains that the Clearinghouse

provides the licensing authorization, not the End-User Player Applications (see, e.g., col. 7, lines 11-40).

Colosso also does not teach or suggest a portable media device that includes a controller that is configured to confirm a user license based upon a comparison of a user identifier embedded in the meta-data associated with digital content with a user identifier stored in a memory.

Since neither Downs nor Colosso teaches or suggests the above-mentioned features of claim 4, no permissible combination of Downs and Colosso could have taught or suggested these features to one of ordinary skill in the art at the time of the invention. Accordingly, for at least this additional reason, the Examiner's rejection of claim 4 now should be withdrawn.

#### 4. Claim 6

Claim 6 incorporates the features of claims 1 and 2 and, therefore, claim 6 is patentable for at least the same reasons explained above. Claim 6 also is patentable for the following additional reason.

Claim 6 requires a portable media device that includes a controller that is configured to enable playback of only a sample of the digital content in response to a failed user license confirmation. The Examiner has asserted that Downs discloses this feature. To the contrary, however, Downs fails to even hint that the End-User Player Application could be configured to play only a sample of a digital content. Indeed, Downs clearly teaches that "[o]nly users who have decryption keys can unlock the encrypted content" (col. 7, lines 31-32), and the only playback limitations suggested in Downs are limits on the number of times that a digital content may be played and the time period during which digital content may be played.

Colosso does not teach or suggest anything about enabling playback of only a sample of the digital content in response to a failed user license confirmation.

Since neither Downs nor Colosso teaches or suggests the above-mentioned features of claim 6, no permissible combination of Downs and Colosso could have taught or suggested these features to one of ordinary skill in the art at the time of the invention. Accordingly, for at least this additional reason, the Examiner's rejection of claim 6 now should be withdrawn.

5. Claims 7-10

Each of claims 7-10 incorporates the features of independent claim 1 and therefore these claims are patentable for at least the same reasons explained above. These claims also are patentable for the following additional reasons.

Claim 7 requires a portable media device that includes a controller that is configured to direct received digital content selectively to unrestricted memory storage or to restricted memory storage based upon a user license confirmation. The Examiner has asserted that Downs discloses this feature. Contrary to the Examiner's assertion, however, Downs does not teach or suggest anything about a memory system that is segmented into unrestricted memory storage and restricted memory storage, much less anything about directing received digital content selectively to unrestricted memory storage or to restricted memory storage based upon a user license confirmation. The Summary section of Downs, which is cited by the Examiner to support her assertion, only relates to the encryption and decryption of data; there is no hint whatsoever relating to directing received digital content selectively to unrestricted memory storage or to restricted memory storage based upon a user license confirmation.

Colosso also fails to teach or suggest anything about directing received digital content selectively to unrestricted memory storage or to restricted memory storage based upon a user license confirmation.

Since neither Downs nor Colosso teaches or suggests the above-mentioned features of claim 7, no permissible combination of Downs and Colosso could have taught or suggested these features to one of ordinary skill in the art at the time of the invention. Accordingly, for at least this additional reason, the Examiner's rejection of claim 7 now should be withdrawn.

Claims 8-10 incorporate the features of claim 7 and therefore these claims are patentable for at least the same reasons.

6. Claim 11

Claim 11 incorporates the features of independent claim 1 and therefore this claim is patentable for at least the same reasons explained above.

B. Claims 12-20

Claim 12 is an independent claim and claims 13-20 depend from claim 12. Each of these claims requires a digital content distribution system that includes two or more portable electronic devices each of which includes a transceiver for wirelessly transmitting digital content to and wirelessly receiving digital content from another portable media device, and a license manager configured to associate digital content with meta-data for controlling wireless transmission of digital content from one portable media device to another.

1. Independent claim 12

The Examiner has indicated that Downs discloses a digital content distribution system that includes two or more portable media devices and a license manager configured to associate digital content with meta-data for controlling wireless transmission of digital content from one portable media device to another. Contrary to the Examiner's assertion, however, Downs does not teach such a digital content distribution system. With respect to portable consumer devices, Downs only teaches that digital content may be copied to a portable consumer device (see, e.g., col. 8, lines 48-53). There is no teaching in Downs that a portable consumer device may be configured to transmit digital content to another device. Indeed, the portable consumer device contemplated by Downs is configured to perform a subset of the functions of the End-User Player Application 195 that allows the portable device to process the content's Usage Conditions that are embedded in a watermark (see, e.g., col. 11, lines 47-54). This suggests that portable consumer devices in Downs' approach are not configured to perform other functions of the End-User Player Application 195, such as the function of copying digital content to other devices.

Colosso merely discloses a scheme for regulating the use of licensed products in accordance with which a customer purchases a licensed product from a distributor and subsequently connects to a licensor's database to activate the licensed product. Colosso does not teach or suggest a license manager that is configured to associate digital content with meta-data for controlling wireless transmission of digital content from one portable media device to another.

Since neither Downs nor Colosso teaches or suggests the above-mentioned features of claim 12, no permissible combination of Downs and Colosso could have taught or suggested these features to one of ordinary skill in the art at the time of the invention. Accordingly, for at least this reason, the Examiner's rejection of independent claim 12 now should be withdrawn.

2. Claims 13 and 17

Claims 13 and 17 incorporate the features of independent claim 12 and therefore these claims are patentable for at least the same reasons explained above.

3. Claim 14

Claim 14 incorporates the features of claim 12 and, therefore, claim 14 is patentable for at least the same reasons explained above. Claim 14 also is patentable for the following additional reason.

Claim 14 requires that the license manager be configured to allocate incentives based upon meta-data associated with the purchase of digital content. The Examiner has asserted that Downs teaches this feature. To the contrary, however, Downs does not teach or suggest anything about allocating incentives. The Summary section of Downs, which is cited by the Examiner to support her assertion, only relates to the encryption and decryption of data; there is no hint whatsoever relating to the allocation of incentives by a license manager.

Colosso also fails to teach or suggest anything about a license manager that is configured to allocate incentives based upon meta-data associated with purchased digital content.

Since neither Downs nor Colosso teaches or suggests the above-mentioned features of claim 14, no permissible combination of Downs and Colosso could have taught or suggested these features to one of ordinary skill in the art at the time of the invention. Accordingly, for at least this additional reason, the Examiner's rejection of claim 14 now should be withdrawn.

4. Claims 15, 16, and 18

Each of claims 15, 16, and 18 incorporates the features of claim 12 and, therefore, these claims are patentable for at least the same reasons explained above. These claims also are patentable for the following additional reason.

Each of claims 15, 16, and 18 requires, at least in part, that the license manager be configured to allocate an incentive. As explained above, neither Downs nor Colosso teaches or suggests anything about allocating incentives. Accordingly, for at least this additional reason, the Examiner's rejection of claims 15, 16, and 18 now should be withdrawn.

5. Claims 19 and 20

Each of claims 19 and 20 incorporates the features of claim 12 and, therefore, these claims are patentable for at least the same reasons explained above. These claims also are patentable for the following additional reason.

Each of claims 19 and 20 requires, at least in part, that the licensed distributor be configured to allocate an incentive. As explained above, neither Downs nor Colosso teaches or suggests anything about allocating incentives. Accordingly, for at least this additional reason, the Examiner's rejection of claims 19 and 20 now should be withdrawn.

III. Conclusion

For the reasons explained above, all of the pending claims are now in condition for allowance and should be allowed.

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